

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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MAILED

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Ex parte: YIN PAN, AL VILLARICA AND ERIC EDWARD

S. PATENT AND TRADEMARK OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

Application No. 09/638,373

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ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

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This application was received at the Board of Patent Appeals and Interferences on November 19, 2007. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matter requiring attention prior to docketing is identified below.

**APPEAL BRIEF**

**Summary Of Claimed Subject Matter**

Appellant filed an Appeal Brief dated January 17, 2007, in response to the Final Rejection mailed August 3, 2006. The Appeal Brief is not in compliance with 37 CFR § 41.37(c)(v), effective September 13, 2004. 37 CFR § 41.37(c)(v) states:

*\*\*>(v) Summary of claimed subject matter.* A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which must refer to the specification by page and line number, and to the drawing, if any, by reference characters. While reference to page and line number of the specification *\*\*>requires* somewhat more detail than simply summarizing the invention, it is considered important to enable the Board to more quickly determine where the claimed subject matter is described in the application. *>For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of 37 CFR 41.37(c)(1)(vii), every means plus function and step plus function as*

permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

The “Summary of Claimed Subject Matter” section appearing on page 3-6 of the Appeal Brief filed January 17, 2007, is deficient. Dependent claim 43 contains “means for” language. An explanation of the claimed subject matter for claim 43 must be mapped to the specification by page and line number.

When the Office holds the brief to be defective solely due to appellant’s failure to provide a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v), an entire new brief need not, and should not, be filed. Rather, a paper providing a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v) will suffice. Failure to timely respond to the Office’s requirement will result in dismissal of the appeal. See MPEP § 1215.04 and §711.02(b).

### **CONCLUSION**

Accordingly, it is

**ORDERED** that the application is returned to the Examiner to:

- 1) hold the Appeal Brief filed January 17, 2007, defective;
- 2) notify the appellant to submit a “paper” which corrects the Appeal Brief, Summary of Claimed Subject Matter under 37 § 41.37(c)(1)(v);

- 3) acknowledge and consider of any “paper” that may be submitted by Appellant in response to the Notice of Non-Compliance to correct the Appeal Brief as required by 37 § 41.37(c)(1)(v); and
- 4) for such further action as may be appropriate.

BOARD OF PATENT APPEALS  
AND INTERFERENCES

By:

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PJN/tsj

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